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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,722	02/05/2001	Gordon Michael Wiram	57111-5098	6086
24574	7590	04/06/2005	EXAMINER	
JEFFER, MANGELS, BUTLER & MARMARO, LLP 1900 AVENUE OF THE STARS, 7TH FLOOR LOS ANGELES, CA 90067			MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/777,722

**Applicant(s)**

WIRAM, GORDON MICHAEL

**Examiner**

Steven B. McAllister

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.  
4a) Of the above claim(s) 30 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-29 and 31-52 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The examiner gratefully acknowledges Applicant's response to the supplemental request for information.

#### ***Claim Objections***

It is noted that claims 6, 7, 16, 17, 23 and 24 recite only information included in reports, and are drafted so as to recited elements of the apparatus. Although the elements are not interpreted as limitations to the apparatus, they will be treated as such below in order to further prosecution.

Claims 32-41 are objected to be they fail to meet the requirements of 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 32-41 recite functional elements that are not disclosed as being resident in the server, but rather only in the system as a whole in the original specification and claims. The specification did not describe the invention in such a way as to reasonably convey to one of ordinary skill in the art that the inventory had possession of the claimed invention.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-20, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000 in view of Francisco et al (5,875,433)

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. The system comprised software (inherently embedded on a tangible medium) to provide a number of system software features. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the Pc-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement. The

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system of U-Haul was not operatively connected to the internet. Francisco shows connecting a point of sale system to the internet via a server. It would have been obvious to one of ordinary skill in the art to modify the apparatus of Uhaul by connecting the POS system to the internet in order to provide for automated tax reporting to the relevant tax authority.

As to claims 6, 7, 23 and 24, U-Haul in view of Francisco et al show all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

As to claim 14, U-Haul in view of Francisco et al show all elements except displaying a rental rate. However, to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by having it display the rental rate for equipment in order to provide the customer with information needed in making a rental decision.

As to claims 16 and 17, U-Haul in view of Francisco et al show all elements except the rental agreement including the rental terms of the transaction and an itemized list of charges. However, it is notoriously old and well known in the art to provide this information on a rental agreement. It would have been obvious to one of ordinary skill in the art to provide this information in order to avoid later conflicts and to provide the customer with notice of the terms of the agreement.

Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul in view of Francisco et al as applied to claims 2 and 19 above, and further in view of the Budget reservation system.

Uhaul in view of the well known art shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

Claims 31, 32, and 34-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000.

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the Pc-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and

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recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement. The system of U-Haul does not show that these software features are part of a server. However, it is notoriously old and well known in the art to port a standalone software package to a server for use in a client – server architecture (for example several stand alone income tax preparation programs have been placed on servers and made available via the internet). It would have been obvious to one of ordinary skill in the art to modify the apparatus of U-Haul by placing the functionalities on a server in order to ease software updates to the system.

As to claims 35 and 36, U-Haul in shows all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul as applied to claim 31 above, and further in view of the Budget reservation system.

Uhaul shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

It is noted that claim 42 is interpreted as reciting a client browser having the functionalities of the rental feature and the payment section (i.e., reciting a “fat” client).

Claims 42, 43, and 45-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the U-Haul reservation system prior to 2/5/2000.

Prior to 2/5/2000, a PC based Point of Sale system was in use by U-Haul and certain U-Haul dealers. The system was implemented on personal computers and/or computer networks. This PC-based system included a rental feature having a customer information section and a payment section, a reservation feature having a customer information section and an equipment information section, and a payment section, having a cash section, check section and credit card section. The PC-based system further included a transfer feature having an equipment information section, a reporting feature comprising a closing report, a reservation report, an inventory report, an equipment due report and a refund report, as well as a marketing section having a marketing message relating to the moving equipment rental business. In addition, the Pc-based system included a customer information section that stored and recalled customer information, as well as an equipment information section that stored and recalled information pertaining to a transaction. It also included a rental feature with a printable rental agreement. The system of U-Haul does not show that these software features are resident in the client browser. However, it is notoriously old and well known in the art to provide the software functionalities associated with a standalone system in a “fat” client having a browser interface. It would have been obvious to one of



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ordinary skill in the art to do so in order to facilitate access to remote shared databases while minimizing the load on the server.

As to claims 46 and 47, U-Haul in shows all elements except that the closing report shows a contract number, method of payment, amount received and an amount refunded for all transactions for a specified day. However, it is notoriously old and well known in the art to include such information on a closing report. It would have been obvious to one of ordinary skill in the art to do so in order to fully characterize the transactions occurring during that day.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over U-Haul as applied to claim 42 above, and further in view of the Budget reservation system. Uhaul shows all elements except the return feature. The system of Budget shows this feature. It would have been obvious to one of ordinary skill in the art to further modify the apparatus of U-Haul by using the rental return feature of Budget in order to facilitate easy recall of data and return of equipment.

### ***Response to Arguments***

Applicant's arguments filed 1/13/2005 have been fully considered but they are not persuasive.

Regarding the Applicant's 1.132 affidavit, it is noted that it is not persuasive at least because it argues the merits of an invention which is not necessarily the claimed invention.

For instance, claims 1-18 can be a standalone PC based system, except for a nominal connection to the internet.

Similarly, claims 19-30 can be standalone system on a LAN, the LAN server have a nominal connection to the internet.

Similarly claims 31-41, recite a server, but recites no nexus between the functions associated with the computer readable medium and the server.

Finally, claims 42-52 recite a browser, but recites no nexus between the functions associated with the computer readable medium and the browser.

As claimed, the features and functions of system can be standalone. It is never claimed that any of the functions are accomplished via the internet, merely that a connection exists. So, the *claimed* invention would not necessarily provide the benefits argued by the Applicant.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P. Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

**STEVE B. MCALLISTER**  
**PRIMARY EXAMINER**